



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,369	03/09/2001	Geoffrey B. Rhoads	P0320	7367

23735 7590 08/23/2004

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 250
TUALATIN, OR 97062

EXAMINER

VU, VIET DUY

ART UNIT	PAPER NUMBER
2154	6

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,369

Applicant(s)

RHOADS ET AL.

Examiner

Viet Vu

Art Unit

2154

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2154

1. The current title is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Art Rejections:

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al, U.S. pat. No. 5,978,773, in view of Tow, European Patent Application No. 493,091.

Per claims 22-25, Hudetz discloses a system and method for connecting a user to a remote site over a network comprising:

- a) one or more web servers (24, 26, fig. 1) for providing information for gallery of items (see col 5, lines 55-58),
- b) an index database (60, fig. 1) for storing and indexing data locations, e.g., URLs, according to unique identifiers, e.g., UPC (col 7, lines 1-63),
- c) an encoder for encoding unique identifier to an item, e.g., barcode encoder (col 6, lines 8-60),
- d) an interface (web browser) for accessing the index database using encoded identifier and for accessing the gallery of items at the web server using an address retrieved from the index database (see col 9, lines 5-21).

Hudetz does not explicitly teach using steganographical encoding technique for encoding the identifiers. Tow discloses such use of steganographical encoding technique for embedding address or link data onto a printed document (see Tow's col 4, lines 40-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hudetz with Tow's teachings because it would have enabled embedding private links and/or digital signatures on the items for controlling access to the databases (see Hudetz's col 8, lines 43-53).

Per claim 26, Hudetz does not explicitly teach generating and registering unique identifier and its corresponding network

Art Unit: 2154

address with the index database for each item. An official notice is taken that such registration steps are well known for such index database.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize such registration steps in Hudetz because it would have allowed manufacturers and/or users to register their products/items with the index database (see col 7, lines 29-63).

Per claims 27-32, it would have been further obvious to one skilled in the art to practice Hudetz's invention with any type of items using any conventional type of data encoding techniques including magnetic strips or OCR (see col 10, lines 3-20).

Claims 1-21 and 33-40 are similar in scope as that of claims 22-32 and hence are rejected for the same rationale set forth above for claims 22-32.

Conclusion:

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 703-305-9597. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on (703) 305-8498.

Art Unit: 2154

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-305-9600. The Group fax number is 703-872-9306.



VIET D. VU
PRIMARY EXAMINER

Art Unit 2154

8/19/04